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10 **UNITED STATES DISTRICT COURT**
11 **NORTHERN DISTRICT OF CALIFORNIA**
12 **SAN FRANCISCO DIVISION**

13 ASETEK DANMARK A/S

14 Plaintiff and
15 Counterdefendant,

16 v.

17 COOLIT SYSTEMS, INC.,

18 Defendant and
19 Counterclaimant.

CASE NO. 3:19-cv-00410-EMC

**ASETEK DANMARK A/S'S MOTION
FOR LEAVE TO FILE A TWO PAGE
SUR-SURREPLY RE ITS MOTION TO
STRIKE COOLIT SYSTEMS, INC.'S
INVALIDITY CONTENTIONS
AGAINST U.S. PATENT NO. 8,245,764**

Hearing Date: November 21, 2019

Underlying Motion (Dkt. 52 Under
Submission)

1 Because CoolIT exceeded the Court’s permitted scope by raising several new arguments in
 2 its surreply to Asetek’s Motion to Strike CoolIT’s Invalidity Contentions, Asetek respectfully
 3 requests leave to file a two page sur-surreply to same (Ex. B hereto). The Court allowed CoolIT to
 4 file a surreply of limited scope, to respond to the Basi Declaration “in a factual way” without raising
 5 “any new arguments.” More specifically, the Court said:

6 I’m going to allow CoolIT to file a reply in the form of either a declaration or
 7 something very specific key to the Basi declaration. ***Not any new arguments.*** Try to
 supplement, you know, what it did in a factual way.

8 But to be fair, if there is something about Dr. Basi's declaration -- for instance, saying
 9 that Questel database is a well-known patent search database, et cetera, et cetera, et cetera. If
 10 there is something to rebut that or counter that or impeach that kind of testimony, I will allow
 that.

11 So it's like cross examination. Scope is going to be limited to this surrebuttal, which
 12 I'm allowing, to be limited to the scope of the declaration that was introduced on reply by Dr.
 13 Basi. I'd like to have that filed in a week.

14 Ex. A hereto [Hearing Transcript] at 25:2-14.

15 CoolIT’s surreply and supporting Chan Declaration, however, exceeded the Court’s limited
 16 scope and raised at least the following new arguments:

17 (1) That Dr. Basi, as a non-attorney, is supposedly not qualified to testify regarding the scope
 18 of a diligent prior art search, even though CoolIT itself previously relied on a declaration
 19 from a prior art searcher, Ms. Kelly Bowman, to support its position on the same issue,
 20 and even though estoppel cases applying the “diligent search” standard have consistently
 21 relied on declarations from prior art searchers—not patent attorneys.

22 (2) That searching foreign references is supposedly atypical or not required under the
 23 “diligent search” test, and that a search limited to “English-language databases” should
 24 suffice, even though CoolIT previously asserted that its prior art search was
 25 “international.” [Dkt. 54, CoolIT’s Opp. Brief at 2:20-25, 7:20-24].

26 (3) That the Patent Office’s granting of CoolIT’s reexam request means that its 2012 prior art
 27 search was diligent/sufficient, even though in all estoppel cases the PTO necessarily must
 28

1 have initially considered the prior art references as “strong enough” to start the
2 proceedings.

3 (4) CoolIT has not provided any testimony or evidence that Questel (or similar databases
4 with machine translations of foreign-language references) was not available in 2012, and
5 thus not answered the question specifically posed by the Court in granting leave for the
6 surreply.

7 For the above reasons, Asetek respectfully requests leave to file the sur-surreply attached
8 hereto as Exhibit B.

9 Respectfully submitted,

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11 Dated: December 4, 2019

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